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10/652,247	09/02/2003	Matthew Hertz	3009/3	1863

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EXAMINER

SANTIAGO CORDERO, MARIVELISSE

ART UNIT PAPER NUMBER

2687

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/652,247

Applicant(s)

HERTZ, MATTHEW

Examiner

Marivelisse Santiago-Cordero

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The references cited in the Information Disclosure Statement (IDS) filed on 3/30/2004 have been considered.

Drawings

2. Figures 1-2 and 5 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated (see Background of the Invention). See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "206" (Fig. 2); and "400" and "420" (Fig. 4). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing-sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner

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does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities: the term "weather" (page 8, line 8) should be replaced with --whether--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the limitation "said prefix" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3 and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Rodriguez (Patent No.: 5,983,091).

Regarding claim 1, Rodriguez discloses a method for addressing a message sent by a sender to a mobile device that does not have a valid telephone number, the method comprising the steps of:

a. receiving a prefixed MIN address that includes a two-part prefix (col. 7, lines 58-62; note the dialing prefix and the area code) attached to a non unique, intra-network mobile identification number (col. 7, lines 58-62), said prefixed MIN uniquely defining the mobile device (col. 7, lines 55-62); and

b. routing the message to the mobile device using said prefixed MIN address (col. 7, lines 58-62).

Regarding claim 2, Rodriguez discloses wherein said two-part prefix includes as a first part a MIN identifier and as a second part a network identifier (col. 7, lines 58-62; note the dialing prefix and the area code).

Regarding claim 3, Rodriguez discloses wherein each of said MIN identifier and said network identifier has three digits (Fig. 4A; col. 7, lines 58-62).

Regarding claim 7, Rodriguez discloses a method for routing a message having a recipient address to a mobile device that does not have a valid telephone number, the method comprising the steps of:

a. checking the recipient address (from col. 7, line 58 through col. 8, line 4); and

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b. based on said checking, uniquely identifying said recipient address with the mobile device (from col. 7, line 58 through col. 8, line 4).

Regarding claim 8, Rodriguez discloses the method of claim 7 (see above), wherein said recipient address includes a two-part prefix comprising a mobile identification number (MIN) identifier (col. 7, lines 55-65; note the dialing prefix) and a network identifier (col. 7, lines 55-65; note the area code), said recipient address further including a MIN (col. 7, lines 55-65).

9. Claims 7, 11, 16-18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Knotts (Pub. No.: US 2002/0045309).

Regarding claim 7, Knotts discloses a method for routing a message having a recipient address to a mobile device that does not have a valid telephone number, the method comprising the steps of:

- a. checking the recipient address (col. 6, paragraph [0093]); and
- b. based on said checking, uniquely identifying said recipient address with the mobile device (col. 6, paragraph [0093]).

Regarding claim 11, Knotts discloses a system for routing SMS messages to mobile devices that do not have valid telephone numbers comprising:

- a. a receive message function operative to receive a message having a recipient address that includes a prefix attached to a second section of a number (col. 6, paragraphs [0089] [0093]);
- b. a routing message function operative to identify the mobile device based on said recipient address, said routing function further operative to remove said prefix (col. 6, paragraphs [0092]-[0093]); and

c. a send message function for sending said message to the mobile device (col. 6, paragraphs [0093]-[0095]).

Regarding claim 16, Knotts discloses a system for routing SMS messages to mobile devices comprising:

a. a receive message function operative to receive a message having a recipient address (col. 6, paragraph [0093]);

b. a routing message function operative to decide, based on said recipient address, if said recipient address has a valid or non-valid telephone number (col. 6, paragraph [0093]); and

c. means to send said message to said recipient address (col. 6, paragraphs [0093]-[0095]).

Regarding claim 17, in the obvious combination, Knotts discloses wherein said recipient address is a valid telephone number, and wherein said means include means to route valid telephone numbers (col. 6, paragraph [0093]).

Regarding claim 18, in the obvious combination, Knotts discloses wherein said recipient address is a number comprising a prefix + second section, said prefix indicating that said recipient address is a non-valid telephone number (col. 6, paragraphs [0089] and [0093]-[0095]).

Regarding claim 20, in the obvious combination, Knotts discloses wherein said routing function is further operative to remove said prefix and leave said second section as an address identifying the mobile device (col. 6, paragraphs [0089] and [0092]).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 4-6 and 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez in view of Applicant's admitted prior art.

Regarding claim 4, Rodriguez discloses the method of claim 1 (see above), wherein said step of routing includes searching a database (from col. 7, line 65 through col. 8, line 1; note that the database is inherently present in order to compare the number to a set already established) identified by said network identifier (from col. 7, line 65 through col. 8, line 1), and removing said prefix from said prefixed MIN address, thereby leaving a recipient address comprising only said MIN (Fig. 4A; col. 7, line 58-65).

Rodriguez fails to disclose searching a database for a destination network.

However, Applicant's admitted prior art discloses wherein said identifying further includes identifying a destination network from said network identifier (Background of the Invention, page 2, lines 29-31).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to search the database of Rodriguez for destination network as suggested by Applicant's admitted prior art.

One of ordinary skill in this art would have been motivated to search the database for destination network because it would assure that the correct recipient receives the message.

Regarding claim 5, in the obvious combination, Applicant's admitted prior art discloses wherein, if said destination network is found, said step of routing further includes sending said message to said MIN on said destination network (Background of the Invention, page 2, lines 30-31).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to send said message to said MIN of Rodriguez on said destination network if said destination network is found as suggested by Applicant's admitted prior art.

One of ordinary skill in this art would have been motivated to send said message to said MIN on said destination network if said destination network is found because it would assure that the correct recipient receives the message.

Regarding claim 6, in the obvious combination, Applicant's admitted prior art discloses wherein, if said destination network is not found, said step of routing further includes generating an error message sent back to the sender (Background of the Invention, page 2, lines 31-32).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to incorporate in said step of routing of Rodriguez to generate an error message sent back to the sender if said destination network is not found as suggested by Applicant's admitted prior art.

One of ordinary skill in this art would have been motivated to incorporate in said step of routing of Rodriguez to generate an error message sent back to the sender if said destination network is not found because it would notify the sender and permit him/she to try another form of communication.

Regarding claim 9, Rodriguez discloses the method of claim 8 (see above). Rodriguez fails to disclose wherein said identifying further includes identifying a destination network from said network identifier.

However, Applicant's admitted prior art discloses wherein said identifying further includes identifying a destination network from said network identifier (Background of the Invention, page 2, lines 27-31).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to further identify a destination network from said network identifier of Rodriguez as suggested by Applicant's admitted prior art.

One of ordinary skill in this art would have been motivated to further identify a destination network from said network identifier because it would assure that the correct recipient receives the message.

Regarding claim 10, in the obvious combination, Rodriguez discloses further comprising removing said two-part prefix and sending said message to the mobile device identified by said MIN on said destination network (col. 7, lines 58-65).

Regarding claim 11, Rodriguez discloses a system for routing messages to mobile devices that do not have valid telephone numbers comprising:

a. a receive message function operative to receive a message having a recipient address that includes a prefix attached to a second section of a number (col. 7, lines 29-35 and lines 58-62);

b. a routing message function operative to identify the mobile device based on said recipient address, said routing function further operative to remove said prefix (from col. 7, lines 58-65); and

c. a send message function for sending said message to the mobile device (from col. 7, lines 58-65).

Rodriguez fails to disclose SMS messages.

However, Applicant's admitted prior art discloses SMS messages (Background of the Invention, page 2, lines 25-29).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to use the messages of Rodriguez as SMS messages as suggested by Applicant's admitted prior art.

One of ordinary skill in this art would have been motivated to use the messages of Rodriguez as SMS messages because it is the fastest growing service in the wireless industry (Applicant's admitted prior art: page 1, lines 18-19).

Regarding claim 12, in the obvious combination, Rodriguez discloses wherein said prefix includes a MIN identifier that indicates that said second section is a MIN (col. 7, lines 58-65; note the dialing prefix), said prefix further including a network identifier (col. 7, lines 58-65; note the area code). Rodriguez fails to disclose identifying the destination network of the mobile device.

However, Applicant's admitted prior art discloses identifying the destination network of the mobile device (Background of the Invention, page 2, lines 27-31).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to identify a destination network of the mobile device of Rodriguez as suggested by Applicant's admitted prior art.

One of ordinary skill in this art would have been motivated to identify a destination network of the mobile device because it would assure that the correct recipient receives the message.

Regarding claim 13, in the obvious combination, Rodriguez discloses wherein said MIN identifier and said network identifier include each three digits (Fig. 4A; col. 7, lines 58-62).

Regarding claim 14, in the obvious combination, Rodriguez discloses wherein said network identifier is included in a network identifiers database (col. 7, lines 65-67; note that the database is inherently present in order to compare the number to a set already established), said routing message function communicating with said network identifiers database (from col. 7, line 65 through col. 8, line 4). Rodriguez fails to disclose in said operation to identify said destination network.

However, Applicant's admitted prior art discloses routing message function communicating with a database in said operation to identify said destination network (Background of the Invention: page 2, lines 29-31).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to communicate with said network identifiers database of Rodriguez in said operation to identify said destination network as suggested by Applicant's admitted prior art.

One of ordinary skill in this art would have been motivated to communicate with said network identifiers database in said operation to identify said destination network because it would assure that the correct recipient receives the message.

Regarding claim 15, in the obvious combination, Rodriguez discloses wherein said prefix is stripped by said routing function, leaving said MIN, and wherein said send message function is used to send the message to said MIN on said destination network (from col. 7, line 58 through col. 8, line 1).

Regarding claim 16, Rodriguez discloses a system for routing messages to mobile devices comprising:

- a. a receive message function operative to receive a message having a recipient address (col. 7, lines 55-62);
- b. a routing message function operative to decide, based on said recipient address, if said recipient address has a valid or non-valid telephone number (from col. 7, line 55 through col. 8, line 1); and
- c. means to send said message to said recipient address (col. 7, lines 55-62).

Rodriguez fails to disclose SMS messages.

However, Applicant's admitted prior art discloses SMS messages (Background of the Invention, page 2, lines 25-29).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to use the messages of Rodriguez as SMS messages as suggested by Applicant's admitted prior art.

One of ordinary skill in this art would have been motivated to use the messages of Rodriguez as SMS messages because it is the fastest growing service in the wireless industry (Applicant's admitted prior art: page 1, lines 18-19).

Regarding claim 17, in the obvious combination, Rodriguez discloses wherein said recipient address is a valid telephone number, and wherein said means include means to route valid telephone numbers (col. 7, lines 58-62).

Regarding claim 18, in the obvious combination, Rodriguez discloses wherein said recipient address is a number comprising a prefix + second section, said prefix indicating that said recipient address is a non-valid telephone number (from col. 7, line 62 through col. 8, line 1).

Regarding claim 19, in the obvious combination, Rodriguez discloses wherein said prefix includes as a first part a mobile identification number (MIN) identifier that identifies said second section as a MIN (col. 7, line 58-62; note the dialing prefix), and as a second part a network identifier that identifies a destination network associated with said MIN (col. 7, line 58-62; note the area code), said network identifier stored in a network identifiers database (from col. 7, line 58 through col. 8, line 1; note that the database is inherently present in order to compare the number to a set already established).

Regarding claim 20, in the obvious combination, Rodriguez discloses wherein said routing function is further operative to remove said prefix and leave said second section as an address identifying the mobile device (Fig. 4A; col. 7, line 58-65).

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Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marivelisse Santiago-Cordero whose telephone number is (571) 272-7839. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 9/6/05

LESTER G. KINCAID
SUPERVISORY PRIMARY EXAMINER